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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/784,876	02/24/2004	Hirotaka Chiba	990773A	8677

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EXAMINER	
GRANT II, JEROME	

ART UNIT	PAPER NUMBER
2625	

DATE MAILED: 10/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/784,876	CHIBA ET AL.	
	Examiner	Art Unit	
	Jerome Grant II	2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 29-52 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 29-37 is/are rejected.

7)☒ Claim(s) 38-52 is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date 2-04.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

Detailed Action

1.

Rejection Under Section 101

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

10/784,876	6,744,537
Claim 29	Claim 1
Claim 30	Claims 5 and 6
Claim 32	Claim 8
Claim 33	Claim 9
Claim 34	Claim 10
Claim 35	Claim 11

Claim 29 is anticipated in view of claim 1 of the patent. Claim 29 of the patent application recites: a housing; displacement detecting means; and a reading unit. The same elements are recited in claim 1 of the patent. Therefore, the application claim 29 anticipates patent claim 1.

Claim 30 is obvious since the displacement detecting unit and the displacement computing unit are recited in claim 6 of the patent, not using the same identical description, but referring to the same element which performs the same function as the elements set forth in claim 30.

Claim 32 is identical to claim 8.
Claim 33 is identical to claim 9.
Claim 34 is identical to claim 10.
Claim 35 is identical to claim 11.

Art Rejections

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claim 29 is rejected under 35 U.S.C. 102(e) as being anticipated by Suzuki et al.

Suzuki teaches a image reader 100 for optically scanning medium by means of manual operations, see figure 1, the device is operated via hand held.

Suzuki teaches a housing 1, having a reading surface (bottom surface 14, taught at col. 5, lines 15-21) for coming in contact with a medium to be read; a displacement detecting unit (70, taught at col. 5, lines 15-22 for sensing when the reader is in a position to perform reading; an image reading unit, including image

reading sensor 80, image sensor driver 303 and CPU 300 for reading an image when sensor 70 detects that the reader is in a position, see figure 6.

3.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 30-32 and 34-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki in view of Chiu.

With respect to claim 30, Suzuki teaches all of the subject matter upon which the claim depends, see the rejection to claim 29.

Suzuki does teach the use of rollers 241-245 but not for the purpose of computing a displacement.

Chui teaches a hand held scanner 100, shown in figure 1, including a sensor 320 and a plurality of rollers 116 and 118. See figure 3c and figure 5. The rollers are for the purpose of measuring displacement of the sensor with respect to a medium to be read. The rollers are connected to an encoder which measures the movement of the scanner with respect to the medium (figure 4 shows the best illustration).

Since, Suzuki and Chui are both directed toward hand held scanners and include rollers at the position of image reading, it would have been obvious to combine the teachings such that the rollers in Suzuki are replaced by the rollers 116 and 118 of Chui and that the CPU 300 is modified to include instructions or a program that would measure the displacement of the movement of the housing in addition to the encoder mechanism of Chui for converting the movement of the roller to a physical distance, as set forth in figure 4 of Chui.

This combination of the prior art would make obvious the invention of applicant. It is clear that such a combination is well within the level of ordinary skill in the art.

With respect to claim 31, Suzuki teaches a plurality of auxiliary rollers and some of the rollers are between other of the rollers. See figures 3 and 4 of Suzuki.

With respect to claim 32, Suzuki teaches a read control unit (the combination of the CPU 100 and sensor 70) for determining when a reading is about to commence, i.e., when the sensor detects the medium, and when the reading is about to terminate, i.e., when the sensor does not detect the medium after first detecting it.

Chui also teaches this limitation via microprocessor 602, sensors 308, 310 and 312 and the encoder circuit shown in figure 4. When the aforementioned elements are operable, they since the movement of the scanner. Thus the encoder generates signals which are correlated with measurement of displacement of the scan as well as

the speed of the scan. The measurements correlate the beginning and termination of a scan operation.

With respect to claim 34, the power unit is element 17, as discussed at col. 4, lines 35-40.

With respect to claim 35, the memory units are 301 and 302 of Suzuki.

With respect to claim 36, see the communication interface18 of figure 6.

With respect to claim 37, the transmitting means is the USB interface 16.

4.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jerome Grant II whose telephone number is 571-272-7463. The examiner can normally be reached on Mon.-Thurs. from 9:00 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David K. Moore, can be reached on 571-272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

J. Grant II